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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TC 1700

In re Application of: Gyanesh P. Khare

Serial No.: 10/021,982

Group Art Unit: 1764

Filed: November 28, 2001

Examiner: James Arnold, Jr.

For: DESULFURIZATION AND NOVEL SORBENT FOR SAME

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 1-63 are currently pending in the application.

Responsive to the Requirement for Election, Applicant hereby elects the claims of Group I, Claims 1-47 drawn to a sorbent and process of making the sorbent, classified in Class 502, Subclass 20, but respectfully requests reconsideration of the requirement for restriction for the reasons given below.

Non-elected Group II, Claims 48-61, drawn to a desulfurization process, classified in Class 208, Subclass 208R, and non-elected Group III, Claims 62-63, drawn to a desulfurization product, classified in Class 208, Subclass 16 are retained in this application pending reconsideration of the Requirement for Restriction.

The Requirement for Restriction is respectfully traversed. The Requirement for Restriction is based, at least in part, on the grounds that the invention(s), as set forth in the Office Action, are distinct and have acquired a separate status in the art as shown by the cited classifications and that the fields of search are not the same. Every art class referred to in the Office Action properly would be searched, even if the Group II and Group III claims did not exist. Claims 48-61 claim a process that uses the composition claimed in the Group I claims and Claims 62 and 63 claim a desulfurization product resulting from the process, which uses the composition, claimed in the Group I claims.

The claims of Group I, drawn to a sorbent and process for making the sorbent, Group II, drawn to a desulfurization process using the composition of the Group I claims, and Group III, drawn to a desulfurization product resulting from the process of Group II which uses the composition of Group I, are so closely related in this application to be allowable in a single application. Both groups of claims clearly relate to entire processes, either in whole or in part, useful for sulfur removal and the resultant products. The Examiner alleges that the Group I and Group II claims have different functions. Applicant respectfully suggests that the desulfurization process, as claimed in the Group II claims, is intimately related to sorbent compositions claimed in Group I claims. The Examiner also alleges that the Group I and Group III claims are unrelated because they have different functions. Applicant respectfully suggests that the desulfurization products, as claimed in Group III claims, are intimately related to the sorbent composition claimed in the Group I claims because the process resulting in the Group III product uses the composition claimed in the Group I claims. The Examiner alleges that the products as claimed in the Group III

claims can be made by a materially different process. Applicant respectfully suggests that the desulfurization process, as claimed in the Group II claims is intimately related to the product claimed in the Group III claims. The Examiner is respectfully requested to see the examples of the pending application, which provide data to show that the composition in the Group I claims can be used in the process claimed in the Group II claims and is therefore intimately related to the product claimed in the Group III claims.

Furthermore, the Examiner is respectfully requested to refer to MPEP 803, second paragraph, which encourages combination, such as the combination of Group I and Group II and Group III claims in this application.

The Examiner is respectfully requested to withdraw the rejection of Claims 1, 2, 5-8, 10 and 11 under 35 U.S.C.102 (e) as being anticipated by Sughrue et al. (U.S. 6,254,766). Attached is a declaration submitted under 37 C.F.R. 1.131, signed by Gyanesh Khare, the inventor, stating that the idea was conceived and the invention reduced to practice, in the United States, prior to August 25, 1999.

The Examiner is respectfully requested to withdraw the rejection of Claims 3, 4, 9, 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Sughrue et al. (U.S. 6,254,766) in view of Kinoshita et al. (U.S. 6,068,824). Attached is a declaration submitted under 37 C.F.R. 1.131, signed by Gyanesh Khare, the inventor, stating that the idea was conceived and the invention reduced to practice in the United States, prior to August 25, 1999.

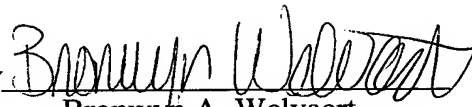
The Examiner is respectfully requested to withdraw the rejection of Claims 14-45 under 35 U.S.C. 103(a) as being unpatentable over Sughrue et al. (U.S. 6,254,766). Attached is a declaration submitted under 37 C.F.R. 1.131, signed by

Gyanesh Khare, the inventor, stating that the idea was conceived and the invention reduced to practice in the United States, prior to August 25, 1999.

In view of the foregoing remarks, Claims 1-63 are believed to be in condition for allowance. Therefore, early allowance of Claims 1-63 is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on

15 October 2003


(Date)
Bronwyn A. Welvaert